



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,681	10/05/2006	Nicole Eggers	PAT-01236/BC1-0083	2779
77224	7590	11/19/2009	EXAMINER	
Mary E. Golota Cantor Colburn LLP 201 W. Big Beaver Road Suite 1101 Troy, MI 48084			FRANK, NOAH S	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			11/19/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MARJORIE.ELLIS@BASF.COM
Mgolota@CantorColburn.com
usptopatmail@cantorcolburn.com

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 11/2/09 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments that the Office Action's case for obviousness relies on fortuitous choices of certain optional components while at the same time relying on restrictions away from other optional components, it is only necessary that module B not have optional binder and that optional module E be present. These two combinations result in four possible choices, 25% of which result in the claimed invention. Module A preferably contains hydroxyl groups as crosslinkable functional groups (§0025) and module E preferably contains isocyanate groups when used with the preferred binders (§0059). Furthermore, the examples use hydroxyl functional binders with chlorinated polyolefins and an isocyanate crosslinker. As far as

Art Unit: 1796

solvent vs. aqueous, this choice is usually dependent on the application conditions or intended use. However, even assuming that this were a completely mathematical decision, there remain only two variable; presence or absence of binder in module B and choice of solvent. These variables yet again only result in four possible choices, 25% of which result in the claimed invention. While this analysis does rely on the fact that Hellmann prefers some embodiments, binder is not a required component of module B. As such, it is still proper to use Hellmann for all that it teaches, but not include one of the preferred components, as its presence is optional.

In response to applicant's arguments regarding claim 23, while "consisting of" does limit a claim to the particular components, claim 23 is directed to, "A multicomponent system comprising at least three components, consisting of." As long as the reference teaches the claimed components I, II, and III, the transitional phrase "comprising" allows for the presence of other components.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOAH FRANK whose telephone number is (571)270-3667. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NF
11-9-09

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796